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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,987	12/28/2001	Glenn M. Baruck	214098	9148
23460	7590	04/09/2004	EXAMINER	
LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6780				KAVANAUGH, JOHN T
		ART UNIT		PAPER NUMBER
		3728		

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/033,987	BARUCK, GLENN M.
	<b>Examiner</b>	<b>Art Unit</b>
	Ted Kavanaugh	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 18 February 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-31 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2-18-04 has been entered.

### ***Opening Comments***

The examiner acknowledges that there is a difference between a "ballet slipper" and a "pointe shoes", as applicant points out in his remarks filed 2-18-04. "Ballet slippers have a soft toe and not a rigid toe box as in a pointe shoe"; page 3, lines 3-4. "Pointe dancing is an altogether distinct style...pointe shoe includes a toe box often made of rigid material resulting in sufficient strength for standing on pointe", page 3, lines 7-11. Therefore, in the prior art, any Ballet type shoe (e.g. ballet slipper) that has a rigid toe box is a pointe shoe and will be regarded as such.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4,19,22,23,30,31 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5682685 (Terlizzi).

Terlizzi teaches a pointe shoe for ballet dancing comprising an upper (12), a rigid plastic toe box (70) with a flat tip (see figure 2), a front sole (40) and a rear sole (32). Regarding the method claims, they are merely a listing of pointe shoe and don't involve any method steps.

4. Claims 1-5,14-16,19,23,30,31 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2002/0078591 (Morrone).

Morrone teaches a pointe shoe (see paragraph #7) for ballet dancing comprising an upper, a rigid plastic toe box (pointe shoes have rigid toe boxes) with a flat tip (see figure 2), a midsole (22,32,42), a front sole (20,30) and a rear sole (40). Regarding the method claims, they are merely a listing of pointe shoe and don't involve any method steps.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4453996 (Terlizzi et al) in view of US 5682685 (Terlizzi).

Terlizzi '996 teaches a pointe shoe having a satin upper (14), a rigid toe box (12,50) with a flat surface a leather sole (22), a leather shank and midsole (shank 20 is made out of leather and consist of layers 21,23; one layer can be considered the leather midsole and the other layer the leather shank), a cotton sock liner (94) substantially as claimed except for the sole being a split sole (a front sole and a rear sole), the sole attached by adhesive or sewing (claims 5 and 6, respectively), the shank and midsole made out of redboard (claim 12 and 18, respectively).

Terlizzi '685 teaches providing a split sole for any pointe shoe, see col. 2, lines 30-35 and lines 62-63. It would have been obvious to provide the pointe shoe of Terlizzi '996 with a split sole, as taught by Terlizzi '685, to allow the pointe shoe with sufficient flexibility

Regarding the size of the shank (i.e. full, three fourth and one-half), in the specification applicant points out that multiple different size shanks can be used and therefore the size of the shank is merely preferred. Accordingly, the claimed shank size (i.e. full, three-fourth and one-half) merely amounts to a matter of engineering design choice and thus does not serve to patentable distinguish the claimed invention over the prior art. This view is buttressed by applicant's disclosure, which does not reveal that the use of the specific size shank solves any particular problem and/or yields any unexpected results. Therefore, it would appear to be obvious to construct the shank of any desired length depending on the particular wearer.

Regarding the soles attached to the upper by adhesive or sewing, it would have been obvious to attach the soles as taught above to the upper by adhesive or stitching inasmuch as substitute the one fastener for another is of no apparent patentable criticality and because a number of different fastening means appear suitable. The examiner takes official notice that it is old and conventional in the art to attach a sole to the upper by adhesive and/or stitching. Using

adhesive would be a simpler means of attaching the components together and stitching would provide a more secure attachment.

Regarding the different material being claimed (i.e. shank and midsole being made out of redboard ; toe box is made out of paper and glue or paper, glue and fiber or plastic), it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the shank, toe box and upper out of these materials as claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 30 and 31, the pointe shoe as taught above follow the obvious method of assembly the shoe as claimed.

7. Claims 1-6,8-26,28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5035069 (Minden) in view of US 5682685 (Terlizzi).

Minden teaches a pointe shoe having a satin upper (28, see col. 6, lines 3-5), a rigid toe box with a flat surface (12, see col. 4, lines 47-49), the toe box is typically formed with a rigid toe box made out of paper, glue, fabrics, cardboard, etc. (see col. 1, lines 14-28) and plastic (see col. 4, lines 11-13); a sole attached by adhesive, a shank (see col. 4, line 65 to col. 5, line 5), a midsole (24), a sock liner and a flat tip toe box and the materials substantially as claimed except for the sole being a split sole (a front sole and a rear sole), the sole attached by adhesive or sewing (claims 5 and 6, respectively), the shank and midsole made out of the materials as claimed (claims 12-13 and 17-18, respectively). Terlizzi teaches providing a split sole for any pointe shoe, see col. 2, lines 30-35 and lines 62-63. It would have been obvious to provide the

pointe shoe of Minden with a split sole, as taught by Terlizzi, to allow the pointe shoe with sufficient flexibility. Regarding the size of the shank (i.e. full, three fourth and one-half), Minden teaches using these sizes at col. 4, line 65 to col. 5, line 5.

Regarding the soles attached to the upper by adhesive or sewing, it would have been obvious to attach the soles as taught above to the upper by adhesive or stitching inasmuch as substitute the one fastener for another is of no apparent patentable criticality and because a number of different fastening means appear suitable. The examiner takes official notice that it is old and conventional in the art to attach a sole to the upper by adhesive and/or stitching. Using adhesive would be a simpler means of attaching the components together and stitching would provide a more secure attachment.

Regarding the different material being claimed (i.e. shank is redboard or leather; toe box is made out of paper and glue or paper, glue and fiber or plastic), it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the shank, toe box and upper out of these materials as claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding the sock liner, the examiner takes official notice that cotton sock liners are old and conventional in the art and are used to provide additional comfort to the wearer. Therefore, it would have been obvious to provide the pointe shoe as taught above with a sock liner to provide additional comfort.

Regarding claim 30 and 31, the pointe shoe as taught above follow the obvious method of assembly the shoe as claimed.

### ***Conclusion***

8. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F.R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

9. Information about your application can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov). Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Telephone inquiries regarding other general questions, by persons entitled to the information, “should be directed to the group clerical personnel and not to the examiners” M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 (FORMAL FAXES ONLY). Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Art Unit: 3728

If in receiving this Office Action it is apparent to applicant that certain documents are missing, requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached from 6AM - 4PM.



Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK

April 6, 2004